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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,682	01/10/2001	Fahri Saatcioglu	586.02-US1	6146

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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 03/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/743,682

Applicant(s)

SAATCIOGLU, FAHRI

Examiner

Stephen L. Rawlings, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Election facsimile cover sheet*.

### DETAILED ACTION

1. The amendment filed January 10, 2001 in Paper No. 3 is acknowledged and has been entered. Claims 5 and 6 have been amended. Claims 33-36 have been added.
2. The amendment filed July 13, 2001 in Paper No. 5 is acknowledged and has been entered.
3. Claims 1-36 are pending in the application and are currently subject to restriction.

### *Election/Restrictions*

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 5-10, 13, ~~14~~ and 15-20, drawn to a polynucleotide comprising a nucleotide sequence that is at least 90% identical to the nucleotide sequence set forth in SEQ ID NO: 3, a polypeptide comprising an amino acid sequence that is at least 90% homologous to the amino acid sequence set forth in SEQ ID NO: 10, and a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 17 with a presence of a neoplastic cell.

Group II, claim(s) 3, 7, 8, 33, and 35, drawn to a polynucleotide comprising a nucleotide sequence that is at least 90% identical to the nucleotide sequence set forth in SEQ ID NO: 4.

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Group III, claim(s) <sup>4</sup>3, 7, 8, <sup>34</sup>33, and <sup>+ 36</sup>35, drawn to a polynucleotide comprising a nucleotide sequence that is at least 90% identical to the nucleotide sequence set forth in SEQ ID NO: 7.

Group IV, claim(s) <sup>11, 13, 14</sup>3, 7, 8, 33, and 35, drawn to a polypeptide comprising an amino acid sequence that is at least 90% identical to the nucleotide sequence set forth in SEQ ID NO: 11.

Group V, claim(s) <sup>12-14</sup>3, 7, 8, 33, and 35, drawn to a polypeptide comprising an amino acid sequence that is at least 90% identical to the nucleotide sequence set forth in SEQ ID NO: 14.

Group VI, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 18 with a presence of a neoplastic cell.

Group VII, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 21 with a presence of a neoplastic cell.

Group VIII, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 17 and SEQ ID NO: 18 with a presence of a neoplastic cell.

Group IX, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 17 and SEQ ID NO: 21 with a presence of a neoplastic cell.

Group X, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 18 and SEQ ID NO: 21 with a presence of a neoplastic cell.

Group XI, claim(s) 15-20, drawn to a method for detecting a neoplastic cell, said method comprising correlating an RNA comprising SEQ ID NO: 17, SEQ ID NO: 18, and SEQ ID NO: 21 with a presence of a neoplastic cell.

Group XII, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 10 with a presence of a neoplastic cell.

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Group XIII, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 11 with a presence of a neoplastic cell.

Group XIV, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 14 with a presence of a neoplastic cell.

Group XV, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 10 and SEQ ID NO: 11 with a presence of a neoplastic cell.

Group XVI, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 10 and SEQ ID NO: 14 with a presence of a neoplastic cell.

Group XVII, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 11 and SEQ ID NO: 21 with a presence of a neoplastic cell.

Group XVIII, claim(s) 21-26, drawn to a method for detecting a neoplastic cell, said method comprising correlating an intracellular polypeptide comprising SEQ ID NO: 10, SEQ ID NO: 11, and SEQ ID NO: 21 with a presence of a neoplastic cell.

Group XIX, claim(s) 27-32, drawn to a method for identifying differentially expressed genes.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. The inventions listed as Groups I-XIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The special technical feature of Group I is the polynucleotide sequence set forth in SEQ ID NO: 3.

The special technical feature of Group II is the polynucleotide sequence set forth in SEQ ID NO: 4.

The special technical feature of Group III is the polynucleotide sequence set forth in SEQ ID NO: 7.

The special technical feature of Group IV is the polypeptide sequence set forth in SEQ ID NO: 11.

The special technical feature of Group V is detecting the polypeptide sequence set forth in SEQ ID NO: 14.

The special technical feature of Group VI is detecting the polynucleotide sequence set forth in SEQ ID NO: 18.

The special technical feature of Group VII is detecting the polynucleotide sequence set forth in SEQ ID NO: 21.

The special technical feature of Group VIII is detecting the polynucleotide comprising SEQ ID NO: 17 and SEQ ID NO: 18.

The special technical feature of Group IX is detecting the polynucleotide comprising SEQ ID NO: 17 and SEQ ID NO: 21.

The special technical feature of Group X is detecting the polynucleotide comprising SEQ ID NO: 18 and SEQ ID NO: 21.

The special technical feature of Group XI is detecting the polynucleotide comprising SEQ ID NO: 17, SEQ ID NO: 18, and SEQ ID NO: 21.

The special technical feature of Group XII is detecting the polypeptide comprising SEQ ID NO: 10.

The special technical feature of Group XIII is detecting the polypeptide comprising SEQ ID NO: 11.

The special technical feature of Group XIV is detecting the polypeptide comprising SEQ ID NO: 14.

The special technical feature of Group XV is detecting the polypeptide comprising SEQ ID NO: 10 and SEQ ID NO: 11.

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The special technical feature of Group XVI is detecting the polypeptide comprising SEQ ID NO: 10 and SEQ ID NO: 14.

The special technical feature of Group XVII is detecting the polypeptide comprising SEQ ID NO: 11 and SEQ ID NO: 14.

The special technical feature of Group XVIII is detecting the polypeptide comprising SEQ ID NO: 10, SEQ ID NO: 11, and SEQ ID NO: 14.

The special technical feature of Group XIX is identifying differentially expressed genes.

Accordingly, the groups of inventions are not linked by the same or a corresponding special technical feature so as to form a single general inventive concept. Furthermore, PCT Rules 13.1 and 13.2 do not provide for unification of more than the first claimed product, the first claimed method of making said product, and the first claimed method for using said product.

7. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A, claim 25, drawn to the method of claim 24 wherein the probe is an antibody or an antibody fragment.

Species B, claim 25, drawn to the method of claim 24 wherein the probe is a natural ligand of the polypeptide.

Species C, claim 25, drawn to the method of claim 24 wherein the probe is a synthetic ligand of the polypeptide.

8. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The special technical feature of Species A is an antibody or an antibody fragment.

The special technical feature of Species B is a natural ligand of a polypeptide.

The special technical feature of Species B is a synthetic ligand of a polypeptide.

Accordingly, the species of invention are not linked by the same or a corresponding special technical feature so as to form a single general inventive concept.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Thursday, alternate Fridays, 8:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.

Examiner

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slr

March 18, 2002

A handwritten signature in black ink, appearing to read 'D. Wortman', with a long horizontal flourish extending to the right.

DONNA WORTMAN  
PRIMARY EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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